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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,423	02/13/2004	C. Yvonne Thiel	T-6201 (538-54)	1117
7590 12/11/2008				
Michael E. Carmen, Esq. M. CARMEN & ASSOCIATES, PLLC Suite 400 170 Old Country Road Mineola, NY 11501				
EXAMINER				
TOOMER, CEPHIA D				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
12/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,423

Applicant(s)

THIEL ET AL.

Examiner

Cephia D. Toomer

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This Office action is in response to the amendment filed August 15, 2008 in which claims 1, 2, 21 and 22 were amended and claims 36-40 were added.

Election/Restrictions

1. Newly submitted claims 36-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: during the prosecution of this application claims directed to a method for improving the drain interval of a diesel engine oil have not been examined. Furthermore, this invention would best be searched in class 508 and not class 44, the classification for the current claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36-40 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9-14, 1-24, 27-30 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esche (US 20040014612) in view of Migdal (US 5,075,383).

Esche teaches a multifunctional fuel additive that improves fuel economy comprising a hydridized, acylated olefin copolymer (see abstract). Preferred copolymers for use in the invention are copolymers of ethylene and one or more C_3 to C_{23} olefins (propylene) and optionally a nonconjugated diene (see paragraph 6). The number average molecular weight of the copolymer is between 700 and about 500,000 (see paragraph 10). An ethylenically unsaturated carboxylic acid such as maleic anhydride is grafted onto the polymer backbone (see paragraph 12). The carboxylic reactant is grafted onto the polymer backbone in amount from about 0.5 to about 6.0 molecules of carboxylic reactant per molecule of polymer backbone (see paragraph 14). Esche uses coupling agents such as organopolyamines to derivatize the copolymer compound, wherein the organo group is aromatic (see paragraphs 19 and 23). In preparing the coupled acylated olefin copolymers of Esche, the molar charge of coupling compound per mole of ethylenically unsaturated carboxylic reagent (maleic anhydride) can vary depending upon the choice of coupling compound (see paragraph 27). This teaching suggests that the proportion may be optimized.

Esche teaches that the hybridized olefin copolymer can be added directly to the fuel (diesel) in an amount from 0.001 to about 0.5 wt %. Esche teaches that conventional additives may be present in the fuel composition (see paragraphs 28, 29 and 30).

Esche differs from the claims in that he does not specifically teach the that the coupling agent is N-arylphenylenediamine. However, Migdal teaches this difference.

Migdal teaches the same dispersant additive as set forth in the present invention (see abstract; col. 6, lines 54-68; col. 7, lines 1-6).

It would have been obvious to one of ordinary skill in the art to choose the claimed N-arylphenylenediamine as the coupling agent because Esche teaches broadly that such compounds are within the scope of his invention and Migdal teaches that the organopolyamine coupling agents of Esche include N-arylphenylenediamine.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Migdal (US 5,075,383).

Migdal teaches the same dispersant additive as set forth in the present invention (see abstract; col. 2, lines 35-68; col. 3, lines 1-56; col. 3, line 65 through col. 4, lines 1-28). Migdal contemplates using the additives in fuel compositions (see col. 10, lines 35-49). Migdal teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Migdal differs from the claims in that he does not specifically teach a diesel fuel composition. However, it would have been obvious to one of ordinary skill in the art to use the additive in diesel fuel because Migdal contemplates using the additive in fuel compositions and this teaching suggests all fuel compositions.

In the second aspect, Migdal differs from the claims in that he does not specifically teach the ratio of amino-aromatic polyamines to grafted copolymer. However, no unobviousness is seen in this difference because Migdal teaches reacting

the polymer with the amino-aromatic polyamine and this teaching suggests a ratio of at least 1:1.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Migdal in view of DeCanio (US 5,925,151).

Migdal has been discussed above. Migdal fails to teach the sulfur content of the diesel fuel or the use of additional additives. However, DeCanio teaches these differences.

DeCanio teaches a diesel fuel composition comprising a detergent additive wherein the fuel may be a low sulfur diesel fuel. The diesel fuel should contain less than 500 ppm sulfur (see abstract; col. 2, lines 56-61).

It would have been obvious to one of ordinary skill in the art to add conventional diesel additives because DeCanio teaches that the additives will perform their attendant function. With respect to the use of the low sulfur diesel fuel, the skilled artisan recognizes that U S environmental regulations dictate the use of low sulfur fuels.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues Esche fails to disclose a diesel fuel composition that is set forth as claimed and that Esche fails to disclose the method for improving the soot dispersancy in the crankcase lubricating oil during engine operation.

Esche differs from the claims in that he does not specifically set forth the claimed coupling agent. Esche teaches that an organopolyamine may be used as the coupling agent. However, there are no specifics regarding this compound. Esche teaches at

paragraph 0002 that U.S. Patent 5,075,383 (Migdal) teaches a similar copolymer that is reacted with an amine coupling compound. Esche incorporates by reference this patent. As the examiner has set forth in the Office action, Migdal teaches that the organopolyamine may be an N-arylphenylenediamine as set forth in the present claims.

Applicant is of the opinion and appears to totally disregard Esche teachings that the coupling agent may be other classes of compounds besides polythiol amines such as aminomercaptotrazole. Esche clearly sets forth that the coupling compounds include organo polyamines, polyhydroxy or thiol amines and amide-amines. It is clear that Esche is not limited to thiol amines as the coupling compound.

Esche teaches that the hybridized olefin co- or ter-polymer of his invention provides methods for improving fuel economy and improving dispersancy.

The arguments directed to claims 36-40 are not addressed because those claims are withdrawn from consideration.

Applicant argues that the skilled artisan would not be led to Migdal because Migdal does not specifically teach that the additive may be used in a diesel engine. Applicant argues that the diesel fuel additive must possess a different set of physical and chemical qualities than those required in gasoline engine application if the additives are to reach the oil coated cylinder surfaces.

The examiner recognizes that gasoline powered engines and diesel powered engines may required different additives. However, it should be noted that some of these additives may be used in both type engines. This is clearly recognized by Migdal because he is not specific as to which type of fuel may be used in his invention, and

Esche teaches that the copolymer may be added to fuels such as diesel fuels and other middle distillate fuels.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cephia D. Toomer/
Primary Examiner
Art Unit 1797

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